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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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WARD KRAFT, INC.		EXAMINER		
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FORT SCOTT, KS 66701				
		ART UNIT	PAPER NUMBER	
		1774		
DATE MAILED: 12/12/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/663,131

Applicant(s)

CRUM, JESSE D.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-9,11,12,14 and 20-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-9,11,12,14 and 20-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 20, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The instant specification does not make a distinction between cuts and ties. It appears ties are synonymous to cuts, but there is nothing in the disclosure to lead either way (see 0058).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 11-14, 20, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,340,512 to Mercer et al.

Mercer teaches a business form (10, FIG. 1 and associated text) with removable, joined, and adjacent integrated cards/labels of paper or cardstock (52/12, 18, and 20, FIG. 1 and associated text, showing transversely extending edges and sides, first and second removable substrates having an inherent thickness distinct dependent upon selecting paper and cardstock), having a plurality of patterns forming leveling aids spaced apart (tape patches 28, 50, and 26,

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FIG. 1 and associated text) that connects and adjoins two said removable substrates. The patterns are composed of segmented strips comprised of adhesive tape, resinous material, or cellophane (col. 3, line 14-15, col. 3, line 28-30, indicia printed on 18 and 20, FIG. 2 and associated text). The form lays flat as shown in FIG. 3 and as Mercer explains at col. 1, line 59 (avoiding unnecessary bulk and thickness for the form). Claims 1-6, 10 and 13-14 (see also col. 4, lines 5-30, col. 2, lines 65-68) are met.

Claim 7 is met as the Figures show a substantially square shape, and that it has a square shape when placed in a stack naturally occurs is suggestive and does not limit the claim.

Claim 11, at least one pattern is disposed on the first substrate, the strips may be provided with indicia (col. 4, lines 20-23).

Claim 12, the surface affinity effect is inherent as the same materials and structure is provided.

Regarding claims 20 and 23, Mercer teaches removable labels and having a form in continuous roll form or fan-folding arrangement (col. 3, line 65-col. 4, line 5). Further, Mercer teaches a business form (10, FIG. 1) with removable, joined, and adjacent integrated cards/labels of paper or cardstock (18 and 20, FIG. 1 and associated text, first and second removable substrates having a property), having a plurality of patterns spaced apart (tape patches 28, 50, and 26, FIG. 1 and associated text) that connects and adjoins two said removable substrates. The patterns are composed of segmented strips comprised of adhesive tape, resinous material or cellophane (col. 3, line 14-15, col. 3, line 28-30). (see also col. 4, lines 5-30, col. 2, lines 65-68) are met. Further to claim 20, that the form "can lay flat" is optional and is not required.

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To claim 22, at least one pattern is disposed on the first substrate (indicia printed on 18 and 20, FIG. 2 and associated text) and the strips may be provided with indicia (col. 4, lines 20-23).

Regarding instant claims 1 and 20, while the thickness differences between first and another or second patterns are not explicitly taught, they are optimizable features. Further to claims 1 and 20, Mercer does not explicitly define the thicknesses or rising amount of the label, patterns to form leveling aids, and form, however, it would have been obvious to one having ordinary skill in the art to have different thicknesses because Mercer teaches the card label is of paper, cardstock or plastic cut into any shape or size (col. 2, lines 65-68) and teaches it is the card and form (the patterns including forming leveling aids are on the form) thickness is an optimizable feature so as to avoid unnecessary bulk (col. 1, lines 50-68). It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. Thicknesses of all the label, patterns, and forms effects the way the continuous forms feed through the printer and the strength.

Claims 15 rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,340,512 to Mercer et al. in view of USPN 4,627,994 to Welsch.

Mercer essentially teaches the claimed invention.

While Mercer teaches removable labels and having a form in continuous roll form or stack arrangement (col. 3, line 65-col. 4, line 5), Mercer does not explicitly teach the removable card labels are self-laminating.

Welsch teaches a continuous business form including self-laminating labels (pressure sensitive adhesive) (48, FIG. 2 and associated text), which construction aids in adhering of the label preventing wrinkling while in a folded stack or roll form of continuous sheets.

It would have been obvious to one having ordinary skill in the art to have modified the form of Mercer to employ self-laminating labels because Welsch teaches the labels may be removed by peeling from the form and aids in adhering of the label preventing wrinkling while in a folded stack or roll form of continuous sheets (Abstract, FIG. 1-2, col. 2, lines 5-55, col. 3, lines 1-20, col. 3, lines 65-68, and col. 4, lines 60-68). The combination of prior art thus produces the instant invention as claimed.

Claims 24 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,340,512 to Mercer et al. in view of USPN 4,627,994 to Welsch.

Mercer teaches removable labels and having a form in continuous roll form or fan-folding arrangement (col. 3, line 65-col. 4, line 5). Further, Mercer teaches a business form (10, FIG. 1 and associated text) with removable, joined, and adjacent integrated cards/labels of paper or cardstock having end edges (52/12, 18, and 20, FIG. 1 and associated text, first and second removable portions with series of cuts and ties as claimed), having a plurality of patterns spaced apart forming a leveling aid (tape patches 28, 50, and 26, FIG. 1 and associated text) that connects and adjoins two said removable portions. The patterns are composed of segmented strips comprised of adhesive tape, resinous material or cellophane (col. 3, line 14-15, col. 3, line 28-30). The form lays flat as shown in FIG. 3 and as Mercer explains at col. 1, line 59 (avoiding unnecessary bulk and thickness for the form). At least one pattern is disposed on the first

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substrate (indicia printed on 18 and 20, FIG. 2 and associated text) and the strips may be provided with indicia (col. 4, lines 20-23). Claims 24, 28, and 26 are met (see also col. 4, lines 5-30, col. 2, lines 65-68).

To claim 27, the surface affinity effect is inherent as the same materials and structure is provided.

Further to claim 24, Mercer does not explicitly define the thicknesses of the label and form as different, however, it would have been obvious to one having ordinary skill in the art to have different thicknesses because Mercer teaches the card label is of paper, cardstock or plastic cut into any shape or size (col.2, lines 65-68) and teaches it is the card and form thickness is an optimizable feature so as to avoid unnecessary bulk (col. 1, lines 50-68). It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. Thickness effects the way the continuous forms feed through the printer.

Further to claim 24, Mercer does not explicitly define the form as a stack, while stating the form is in roll or fan-folding form.

Welsch teaches a continuous business form including self-laminating labels (pressure sensitive adhesive) (48, FIG. 2 and associated text), which construction aids in adhering of the label preventing wrinkling while in a folded stack or roll form of continuous sheets.

It would have been obvious to one having ordinary skill in the art to have modified the form of Mercer to employ a stack consisting of 10 to 10,000 assemblies because Welsch teaches a folded stack or roll form of continuous sheets are equivalents and may contain a variety of

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individual forms as illustrated (Abstract, FIG. 1, col. 2, lines 5-55, col. 3, lines 1-20, col. 3, lines 65-68, and col. 4, lines 60-68).

Claims 8-9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,340,512 to Mercer et al. in view of USPN 6,830,795 to Downs.

Mercer essentially teaches the claimed invention as applied to claims 1 and 20 above.

Mercer does not expressly teach a business form having the pattern stripes selected from wax or silicone coatings (claims 8 and 21) or having a roughened surface (claim 9).

Downs teaches labels used in various carriers such as envelopes and parcels for identification a multilayered adhesive stripes (126, 130, 134, FIG. 1-4) having a coating of wax or silicone (106, 114, 120, FIG. 1-4) on top to aid in easy release when labels are in a stack and a plurality of labels are used in a roll or stack (FIG. 1 and 2). See further col. 1, lines 5-10 and col. 4, lines 20-35.

It would have been obvious to one having ordinary skill in the art to have included wax or silicone to the stripes of Mercer because Downs teaches multilayered adhesive stripes having a coating of wax or silicone on top to aid in easy release when a plurality of labels are in a stack or used in a roll or stack (FIG. 1-4 and col. 4, lines 20-35 of Downs). That the stripes have a roughened surface would be expected because the same material, pattern, and indicia print are applied to the stripes as taught by the prior art.



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Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,340,512 to Mercer et al. in view of USPN 4,627,994 to Welsch and further in view of USPN 6,830,795 to Downs.

Mercer and Welsch essentially teach the claimed invention as applied to claim 24 above.

Mercer does not expressly teach a business form having the pattern stripes selected from wax or silicone coatings (claim 24).

Downs teaches labels used in various carriers such as envelopes and parcels for identification a multilayered adhesive stripes (126, 130, 134, FIG. 1-4) having a coating of wax or silicone (106, 114, 120, FIG. 1-4) on top to aid in easy release when labels are in a stack and a plurality of labels are used in a roll or stack (FIG. 1 and 2). See further col. 1, lines 5-10 and col. 4, lines 20-35.

It would have been obvious to one having ordinary skill in the art to have included wax or silicone to the stripes of Mercer and to modify the combination of Mercer and Welsch because Downs teaches multilayered adhesive stripes having a coating of wax or silicone on top to aid in easy release when a plurality of labels are in a stack or used in a roll or stack (FIG. 1-4 and col. 4, lines 20-35 of Downs).

### ***Response to Arguments***

Applicant's arguments filed 10-04-06 have been fully considered but they are not persuasive.

Applicant argues a series of cuts and ties are not taught. Applicant has not made a persuasive argument because Mercer explicitly shows more than one dotted line to indicate the cuts and ties in FIG. 1.

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Applicant argues the different thicknesses between patterns are not taught, however, as previously set forth, thickness is an optimizable feature.

Applicant argues a bump would occur in Mercer, but has not limited the claims to an exclusion of bumps in the stack and has not shown by way of evidentiary data to overcome the art of record.

Applicant argues the patterns are not adjacent an edge but as shown in FIG. 1 of Mercer, patterns 26, 50, and 28 are all on the edges/sides of all elements including the substrate 52/12, 18, and/or 20.

Applicant appears to read more into the limitations than what is present (not aligned to edges/sides, which is explicitly shown in FIG. 1). Thus, the Examiner notes it would be favorable to prosecution to include more features/elements such as the patterned elements 100, 110, and 120, of instant FIG. 1 and/or FIG. 3, elements 490, 480, 520 in Applicant's specification to distinguish over the prior art. Also note, a possible Double patenting rejection might be in effect over 10/689,944 in subsequent actions. A *prima facie* case has been established, and therefore the burden shifts to the Applicant to submit additional objective evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art. Arguments of counsel cannot take the place of factually supported objective evidence. See, e.g., *In re Huang*, 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984). Until the Applicant has convincingly argued or has provided evidence to the contrary, the rejections are maintained.

Welsh and Downs are still used as referenced above.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

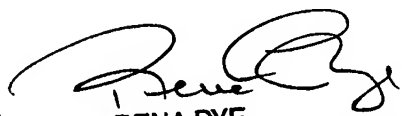
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tamra L. Dicus  
Examiner  
Art Unit 1774

December 7, 2006



RENA DYE  
SUPERVISORY PATENT EXAMINER  
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12/8/06